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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,978	10/31/2003	Atsushi Kikuchi	KIKUCHI=4	8966

1444 7590 10/28/2004

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EXAMINER	
BRUENJES, CHRISTOPHER P	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,978	KIKUCHI ET AL.	
	Examiner	Art Unit	
	Christopher P Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-11* is/are pending in the application.

4a) Of the above claim(s) *3 and 7-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4 and 6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20040429*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1, 2, 4, and 6, in the reply filed on September 10, 2004 is acknowledged. The traversal is on the ground(s) that the inventions are not distinct and there is no serious burden. This is not found persuasive because the inventions are distinct and there is a serious burden. With regards to Groups I and II, the multi-layered container of Group II requires a bottle is formed. A bottle by definition has a smaller mouth portion than the body portion. Therefore, because the same preform could be made to form a container that isn't a bottle the preform can be used to make other final products than the bottle claimed. With regards to Groups I and III, the method as claimed is not required to obtain the claimed product. According to the specification the product must be formed having orientation throughout the preform and no gate portion. As long as injection molding is not used there is no gate portion, and if the extruded preform is cooled sufficiently before blow molding the preform will have orientation throughout the preform. Therefore, the same properties claimed for the preform can be made by more than one method. With regards to the lock of a

serious burden, while searches may be expected to overlap for related inventions, there is no reason to expect they would be coextensive.

The requirement is still deemed proper and is therefore made FINAL.

REPEATED REJECTIONS

2. The 35 U.S.C. 103 rejections of claims 1, 2, 4, and 6 over Nakagawa in view of Yamada are repeated for the reasons previously of record in the Office Action mailed May 18, 2004, Pages 6-8.

ANSWERS TO APPLICANT'S ARGUMENTS

3. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1, 2, 4, and 6 over Nakagawa in view of Yamada have been fully considered but they are not persuasive.

In response to Applicant's argument that Nakagawa teaches direct blow molding. Nakagawa teaches that a multi-layered container is blow molded from an extruded parison having an encapsulated intermediate layer. However, Nakagawa does not teach that the bottle is formed by direct blow molding. Nakagawa does not teach that the extruded parison is extruded directly into the blow-molding mold and certainly does not

explicitly teach that the parison is not drawn and stretched to cause orientation before flow molding. Nakagawa concentrates on the extrusion portion of the preform and bottle making steps and merely states that the bottle formed from the parison is formed by blow molding. Applicant has assumed that Nakagawa does not draw or stretch the parison before blow molding, or that the parison is not substantially cooled before pinching, in order to solidify with orientation. Although this is one method of blow molding an extruded parison it is not the only method, and other methods of blow molding an extruded parison do orient the parison before solidification, which would produce a preform with the center of the bottom portion having a half-width of a diffuse scattering peak by an x-ray diffraction of a surface of the outer layer larger than a half-width of a diffuse scattering peak by an x-ray diffraction of a surface of the inner layer. For strictly illustrative purposes Patents 4,264,558 and 6,074,596 are provided with this office action to show that cooling a parison and/or stretching a parison to orient the plastic before blow molding is well known in the art, and since Nakagawa does not explicitly teach any method steps after the extrusion of the parison, it can not be assumed that the final steps of forming the parison only includes pinching a semi-molten parison and immediately blow molding, as suggested by the

arguments of the Applicant presented on Pages 10-12 of the Paper filed September 10, 2004.

In response to Applicant's argument that Nakagawa teaches a method of producing the hollow plastic product that is incapable of providing applicant's claimed preform. The method of Nakagawa is not incapable of providing applicant's claimed preform as shown above, and when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, the burden is on the applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. See *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, evidence must be provided to show that a product produced by extrusion and orientation before cooling the parison followed by blow molding would not produce a preform having at the center of the bottom

portion, a half-width of a diffuse scattering peak of the outer layer is larger than a half-width of a diffuse scattering peak of the inner layer. The record as a whole is deficient in providing this evidence because the specification only teaches that the product must be made by a process other than injection molding, but fails to provide evidence that the product can only be made by the preferred process of the invention. Furthermore, Nakagawa teaches the preform having a molecular orientation and shape and evidence must be provided to show that the molecular orientation and shape is materially different from a molecular orientation and shape produced by compression molding from a composite molten resin lump.

In response to Applicant's argument that the preform or parison of Nakagawa does not have a bottom, when the parison is added to the blow-molding mold the bottom is closed and therefore the preform at the moment has a bottom.

In response to Applicant's argument that Yamada does not show or describe the deficiencies discussed above with regards to Nakagawa, Yamada has been relied upon for the materials disclosed and not explicitly for the purpose of overcoming the other deficiencies presented by the Applicant with regard to Nakagawa as discussed above.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB
October 26, 2004

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/27/04